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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,152

07/14/2006

Naoto Kuroda

Q95967

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72875

7590

12/12/2008

SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037

EXAMINER

WONG, JOSEPH D

ART UNIT

PAPER NUMBER

2166

NOTIFICATION DATE

DELIVERY MODE

12/12/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@sughrue.com

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USPatDocketing@sughrue.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,152	<b>Applicant(s)</b> KURODA, NAOTO	
	<b>Examiner</b> JOSEPH D. WONG	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081117, 20080717</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Requirement Under 37 CFR 1.105***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The justification for this request is that an instant search report submitted on 6 June 2008 cites the following documents but appropriate copies and machine translations have not been provided. Therefore appropriate copies and machine translations are hereby requested.

JP 2002-334013 A (Sharp Corp.),  
22 November, 2002 (22.11.02),  
Full text; Figs. 1 to 11  
(Family: none)

JP 11-39341 A (NEC Corp.),  
12 February, 1999 (12.02.99),  
Full text; Figs. 1 to 8  
(Family: none)

JP 5-165775 A (NEC Corp.),  
02 July, 1993 (02.07.93),  
Full text; Fig. 1  
(Family: none)

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope

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of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of requirement information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

### ***Information Disclosure Statement***

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered.

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Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Priority***

The justifications for the request to perfect foreign priority are as follows:

- o An intervening date reference of Wang has been applied but would be removed if foreign priority is later if priority is granted and if priority is perfected.
- o Applicant has provided a foreign priority Japanese document appears to show seven figures while the instant English application shows two additional figures which suggest that the subject matter of the instant application appears not supported in its entirety.

Therefore a certified translation of every foreign benefit application or Patent Cooperation Treaty (PCT) application not filed in English is required. 35 U.S.C. 119(b)(3) and 372(b)(3) and 37 CFR 1.55(a)(4). If no certified translation is in the official record for the application, the examiner must require the applicant to file a certified translation. The applicant should provide the required translation if applicant wants the application to be accorded benefit of the non-English language application. Any showing of priority that relies on a non-English language application is prima facie insufficient if no certified translation of the application is on file. 37 CFR 41.154(b) and 41.202(e). Form paragraph 23.19 may be used to notify applicant

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that a certified English translation of the priority document is required. See MPEP 2304.01(b)

Translation of Foreign Benefit Application.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action, 37 CFR 41.154(b) and 41.202(e). Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 2 is rejected for being directed towards nonstatutory subject matter.**

Claim 2 is directed toward a data structure for judging whether a computer apparatus is connected to a network. This apparatus claim does not necessarily recite a physical article within the body of the claim. Consequently it appears directed towards software per se. Therefore claim 2 is rejected.

Applicants can look to MPEP 2106.01-2106.02 (July 2008), Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Instant Specification, and contemporary case law with a matching fact pattern for further suggestions that may be helpful in overcoming these rejections.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Csipkes et al, (US 6,167,401), hereinafter Csipkes.**

**As to claim 1**, Csipkes teaches a network connection presence/absence judging method of judging whether a computer apparatus is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the network connection presence/absence judging method (Fig. 1) comprising: a step of detecting positional information of predetermined data included in an external device connected to the network (Figs. 9, 6a; Col. 3, Lines 10-15; Fig. 2; Col. 3, Lines 9-15), the positional information being described in a hypertext read from a storage medium (Fig. 3a, item 105, “scan serial number” ); a step of displaying (Figs. 5b, 6a, 6b, 8, see serial number “BOARD SN...B1001206”), in accordance with the hypertext (Fig. 5c, 6a, “Details” button; Fig. 8, “BOARD SN” button), a connection presence/absence judgment screen including a message indicating that the predetermined data is displayed in a predetermined position when the computer apparatus is connected to the network (Fig. 6b, “ensure excess wire is clipped at ends after soldering”); and a step of displaying (Fig. 10; Col. 5, Lines 5-10, 20-30; Fig 3c, item 123,

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“display work instructions, graphics and warnings”), when the predetermined data is successfully acquired from the external device (Fig. 6a), the predetermined data in the predetermined position in the connection presence/absence judgment screen (Col. 5, Lines 33-40, “test results fall outside of control specifications”; Figs. 5b-c), and displaying (supra; Fig 3c, item 123, “display work instructions, graphics and warnings”), when the predetermined data is not successfully acquired from the external device (Fig. 3c, item 133, “test prob(sic)”; refers to test problem; Fig. 5b, see tray#), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (Fig. 3c, items 134-5, “auto manif. (sic) prob. (sic)...manual assem. (sic) probl. (sic)”; see pass/fail display in Fig 5b).

**As to claim 2**, Csipkes teaches a data structure for judging whether a computer apparatus is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the data (Fig. 3c, items 124-125, dotted line rectangles) structure comprising: a message tag that is a tag for describing (Fig. 5c, 6a, “Details” button; Fig. 8, “BOARD SN” button, where text on button or label meets tag), when the computer apparatus is connected to the network (Figs. 9, 6a; Col. 3, Lines 10-15; Fig. 2; Col. 3, Lines 9-15), a message indicating that predetermined data is displayed in a predetermined position (Figs. 5b, 6a, 6b, 8, see serial number “BOARD SN...B1001206”); and a positional information tag that is a tag for describing positional information of the predetermined data included in an external device connected to the network (Fig. 6b, “ensure excess wire is clipped at ends after soldering”), and the data structure causing the computer apparatus to execute: a step of detecting positional information of the predetermined data on the basis of the positional information tag (Fig. 5c, 6a, “Details” button; Fig. 8, “BOARD SN” button, where text on button or label meets tag); a step of detecting the message based on the message tag and



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displaying a connection presence/absence judgment screen including the message (Fig. 6b, “ensure excess wire is clipped at ends after soldering”); and a step of displaying (Fig. 10; Col. 5, Lines 5-10, 20-30; Fig 3c, item 123, “display work instructions, graphics and warnings”) when the predetermined data is successfully acquired from the external device on the basis of the positional information (Fig. 3a, item 105, “scan serial number” ), the predetermined data in the predetermined position in the connection presence/absence judgment screen (Col. 5, Lines 33-40, “test results fall outside of control specifications”; Figs. 5b-c) and displaying (supra; Fig 3c, item 123, “display work instructions, graphics and warnings”), when the predetermined data is not successfully acquired from the external device on the basis of the positional information (Fig. 3c, item 133, “test prob(sic)”); refers to test problem; Fig. 5b, see tray#), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (Fig. 3c, items 134-5, “auto manuf. (sic) prob. (sic)...manual assem. (sic) probl. (sic)”; see pass/fail display in Fig. 5b).

**As to claim 3**, Csipkes teaches a storage medium for storing a data structure for judging whether a computer apparatus is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the data structure comprising: a message tag for describing (Fig. 5c, 6a, “Details” button; Fig. 8, “BOARD SN” button, where text on button or label meets tag), when the computer apparatus is connected to the network (Figs. 5b, 6a, 6b, 8, see serial number “BOARD SN...B1001206”), a message indicating that predetermined data is displayed in a predetermined position (Fig. 6b, “ensure excess wire is clipped at ends after soldering”); and a positional information tag for describing positional information of the predetermined data included in an external device connected to the network (Fig. 6b, “ensure excess wire is clipped at ends after soldering”), and

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the data structure causing the computer apparatus to execute: a step of detecting positional information of the predetermined data on the basis of the positional information tag (Fig. 5c, 6a, “Details” button; Fig. 8, “BOARD SN” button, where text on button or label meets tag); a step of detecting the message based on the message tag and displaying a connection presence/absence judgment screen including the message (Col. 5, Lines 33-40, “test results fall outside of control specifications”; Figs. 5b-c); and a step of displaying (supra; Fig 3c, item 123, “display work instructions, graphics and warnings”), when the predetermined data is successfully acquired from the external device on the basis of the positional information (Fig. 3c, item 133, “test prob(sic)”; refers to test problem; Fig. 5b, see tray#), the predetermined data in the predetermined position in the connection presence/absence judgment screen and displaying, when the predetermined data is not successfully acquired from the external device on the basis of the positional information, alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (Fig. 3c, items 134-5, “auto manuf. (sic) prob. (sic)...manual assem. (sic) probl. (sic)”; see pass/fail display in Fig. 5b).

**Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al, (US 2005/0210123 A1), hereinafter Wang.** This is an intervening date reference whose filing date appears between Applicant’s PCT filing date and the foreign priority date.

**As to claim 1,** Wang teaches a network connection presence/absence judging method of judging whether a computer apparatus is connected to a network (Fig. 4, see “green...RPS is connected to network device and works”, paragraph ¶[29]), the network connection

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presence/absence judging method comprising: a step of detecting positional information of predetermined data included in an external device connected to the network (Fig. 4, ¶[29]), the positional information being described in a hypertext read from a storage medium (Fig. 1, ¶[21]); a step of displaying (Fig. 1, item 1210, “web browser”), in accordance with the hypertext (Fig. 1, “HTML”, [21]), a connection presence/absence judgment screen including a message indicating that the predetermined data is displayed in a predetermined position when the computer apparatus is connected to the network (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); and a step of displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is successfully acquired from the external device (¶[16, 29], Figs. 3B, 4), the predetermined data in the predetermined position in the connection presence/absence judgment screen (¶[24-25, 30-31]; Figs. 2, 3A), and displaying (supra), when the predetermined data is not successfully acquired from the external device (Fig. 4, “Gray(off)...RPS is not connected to network device”; Fig. 3B, “Gray(off)...Link down”), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (¶[24-25, 30-31]; Figs. 2, 3A).

**As to claim 2**, Wang teaches a data structure for judging whether a computer apparatus is connected to a network (Fig. 4, see “green...RPS is connected to network device and works”, paragraph ¶[29]), the data structure comprising: a message tag that is a tag for describing (¶[23], “Uniform Resource Locator...URLs of image icons”), when the computer apparatus is connected to the network (Fig. 4, [29]), a message indicating that predetermined data is displayed in a predetermined position (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); and a positional information tag that is a tag for describing positional

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information of the predetermined data included in an external device connected to the network (¶[24-25, 30-31]; Figs. 2, 3A), and the data structure causing the computer apparatus to execute: a step of detecting positional information of the predetermined data on the basis of the positional information tag (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); a step of detecting the message based on the message tag and displaying a connection presence/absence judgment screen including the message (¶[16, 29], Figs. 3B, 4); and a step of displaying (supra), when the predetermined data is successfully acquired from the external device on the basis of the positional information (¶[29], Fig. 4, “Green....Power is working...Green....RPS is connected to network device and works”; ¶[26-27], Fig. 3B, “Green...Link up...Green...Port is operating at 100 Mbps”), the predetermined data in the predetermined position in the connection presence/absence judgment screen and displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is not successfully acquired from the external device on the basis of the positional information (Fig. 4, “Gray(off)...RPS is not connected to network device”; Fig. 3B, “Gray(off)...Link down”. ¶[29]), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (¶[24-25, 30-31]; Figs. 2, 3A).

**As to claim 3**, Wang teaches a storage medium for storing a data structure for judging whether a computer apparatus is connected to a network (Fig. 4, see “green...RPS is connected to network device and works”, paragraph ¶[29]), the data structure comprising: a message tag for describing (¶[23], “Uniform Resource Locator...URLs of image icons”), when the computer apparatus is connected to the network (Fig. 4, ¶[29]), a message indicating that predetermined data is displayed in a predetermined position (¶[24-25, 30-31]; Figs. 2, 3A); and a positional

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information tag for describing positional information of the predetermined data included in an external device connected to the network (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]), and the data structure causing the computer apparatus to execute : a step of detecting positional information of the predetermined data on the basis of the positional information tag (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); a step of detecting the message based on the message tag and displaying a connection presence/absence judgment screen including the message (¶[16, 29], Figs. 3B, 4); and a step of displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is successfully acquired from the external device on the basis of the positional information (¶[29], Fig. 4, “Green....Power is working...Green....RPS is connected to network device and works”; ¶[26-27], Fig. 3B, “Green...Link up...Green...Port is operating at 100 Mbps”), the predetermined data in the predetermined position in the connection presence/absence judgment screen and displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is not successfully acquired from the external device on the basis of the positional information (Fig. 4, “Gray(off)...RPS is not connected to network device”; Fig. 3B, “Gray(off)...Link down”, ¶[29]), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (Fig. 4, “Gray(off)...RPS is not connected to network device”; Fig. 3B, “Gray(off)...Link down”, ¶[29]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is (571) 270-1015. The examiner can normally be reached on Mondays through Fridays from 10 AM – 6PM.

Applicant initiated interviews may be formally requested in advance by faxing a completed PTO-413A form to the examiner's personal fax number at (571) 270-2015. Form PTO-413A is used by the examiner to prepare for any proposed interview. A detailed agenda listing should be attached including any proposed claim language and/or arguments that will be presented. This form is used to determine whether any proposed interview would advance prosecution and fit within a prescribed time limit.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/JDW/

Asst. Examiner, Art Unit 2166

12 December 2008

/K. B. P./

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166